# UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/471,429 | 12/23/1999 | DONALD E. WALLAR II | ST9-99-070 | 7384 |

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| 7590    03/10/2004 | **EXAMINER** |
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| ART UNIT | PAPER NUMBER |
|---|---|
| 2176 | |

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C  (Rev. 10/03)

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _26 January 2004_.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-24_ is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
　　　　application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _9_.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

## DETAILED ACTION

1.     This action is responsive to communications: Request for Reconsideration filed on

11/26/03, Request for RCE filed on 12/29/03 and IDS filed on 1/26/04.

2.     The rejection of claims 1-24 under 35 U.S.C. 103(a) as being unpatentable over Shell in

view of Guck has been withdrawn in light of newly found art.

3.     Claims 1-24 are pending in the case. Claims 1, 8, 10, 15, 20, 21, and 23 are independent

claims.

### *Continued Examination Under 37 CFR 1.114*

4.     A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 12/29/03 has been entered.

### *Information Disclosure Statement*

5 .     The information disclosure statement (IDS) submitted on 1/26/04 has been considered by

the Examiner.

## *Drawings*

6.      The drawings filed on 12/23/99 are objected to as indicated in the attached PTO-948

form.  Formal corrected drawings can be filed at allowance.

## *Claim Rejections - 35 USC § 102*

7.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8.      **Claims 1, 10, 15, and 20-24 are rejected under 35 U.S.C. 102(a) as being anticipated**

**by Guck (USPN 5,911,776 – filed on 12/1996, herein after "Guck").**

**Regarding independent claims 1, 10, 15, 20, 21, and 23**, Guck discloses:

Composing a computer message (on col. 2, lines 1-19 teaches an author could originate a text or

message of his own personal format), comprising the steps of:

(a) presenting a message composition area for entry of an unformatted message (on col.

2, lines 1-19, col. 6, lines 10-28, and col. 12, lines 56-65 teaches an author can create its own

message or document in his own format such as Rich Text Format (RTF) (unformatted); the RTF

is not a tagging language like TIFF, SGML or HTML) and a message format selector for

selecting an output format from a plurality of formats (on col.6, lines 49-64 teaches the user-

sender can change the document by reformatting it in any one of the formats required for the

intended recipients);

a formatted message display area; converting unformatted message to form a formatted

message with format tags of said on of output formats (on col. 5, lines 29-33, col. 6, lines 49-64,

and on col. 9, lines 57-65 teaches converting Rich Text format (an untagged format) into TIFF (a

tagged format); wherein the document will be formatted in TIFF for display).

**Regarding dependent claims 22 and 24,** Guck discloses:

displaying said formatted message for user review (on col. 7, lines 6-10: teaches text of a

document or message can be displayed for review).

9.      **Claim 8 rejected under 35 U.S.C. 102(e) as being anticipated by Ferrel et al. (USPN**

**6,230,173 B1 – filed on 07/1995).**

**Regarding independent claim 8,** Ferrel discloses:

A method of message composition for a computer message file (on col. 22, lines 1-9 teaches

using MPS Word to draft a content which will be placed on the page) , said method comprising:

presenting a message display area (on col. 3, lines 46-65 teaches displayed on-line titles

are created by the editor or author using a Word template (displayed area));

obtaining a formatted message from said computer message file (on col. 3, lines 46-65

and col. 20, line 57 – col. 21, line 26 teaches obtaining the converted rich text document in a

MPML format);

entering said formatted message in said message display area (on col. 21, lines 20-26

teaches MDF (formatted) documents can be used to place embedded objects within the structure

of the document; on col. 22, lines 1-31 teaches author content that is displayed on a page within a

title can be in a format such as HTML);

editing said formatted message to form a revised formatted message; providing said

revised message to said computer message file (on col. 16, lines 5-15 teaches proofing

department where editors, art staff, production staff, and advertising staff reviews the test-

pressing which is the created title formatted in a markup language (see col. 22, lines 20-31)).

*Claim Rejections - 35 USC § 103*

10.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11.     **Claims 2-7, 9, 11-14, and 16-19 are rejected under 35 U.S.C. 103(a) as being**

**unpatentable over Guck, as applied to claims 1, 10, 15, and 20-24 above, in view of Ferrel et**

**al. (USPN 6,230,173 B1 – filed on 07/1995).**

**Regarding dependent claims 2, 11, and 16,** Guck discloses the invention substantially as

claimed as described supra. However, Guck does not explicitly disclose "message formats

include SGML and book manager script".

Ferrel on col. 20, line 57 – col. 21, line 26 and col. 23, lines 30-33 teaches converting

Rich Text (RTF) into a Multimedia Data Format file (MDF); wherein the MDF is the MPML

markup language tagged storage; wherein MPML text derived from SGML and HTML.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a MPML markup language tagged storage, as taught by Ferrel, incorporated into the converting of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

**Regarding dependent claims 3, 12, and 17**, Guck discloses:

a formatted message display area (Guck on col. 5, lines 29-33, col. 6, lines 49-64, and on col. 9, lines 57-65 teaches converting Rich Text format (an untagged format) into TIFF (a tagged format); wherein the document will be formatted in TIFF for display).

**Regarding dependent claims 4, 13, and 18**, Ferrel discloses:

wherein computer instructions for steps (a) and (b) are implemented in Java script (Ferrel on col. 14, line 65 – col. 15, line 3 teaches scripting controls to respond to actions or automatically perform actions at runtime).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a MPML markup language tagged storage, as taught by Ferrel, incorporated into the converting of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

**Regarding dependent claims 5, 14, and 19**, Guck discloses "wherein said unformatted message is a first unformatted message, said formatted message is a first formatted message, said message

area further includes a formatted display area" on col. 5, lines 29-32 teaches converting rich text format (RTF) into the TIFF format (tag format).

Ferrel discloses "in response to entry of a second unformatted message into said second message composition area, converting said unformatted message to form a formatted message with format tags of said one of said output formats; and (d) presenting said first and second formatted messages as a concatenated complete message for display in said formatted message display area", on col. 2, lines 36-47 teaches creating an displaying stories that are formatted from text document into SGML or HTML to be displayed in an on-line network; wherein producing documents that are tagged in either the SGML and HTML format (first and second message composition area); col. 3, lines 46-65 and on col. 20, line 57 – col. 21, line 26 teaches converting Rich Text format (RTF) to a MDF that holds is tagged language MPML (converting unformatted message into format tags).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a MPML markup language tagged storage, as taught by Ferrel, incorporated into the converting of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

**Regarding dependent claim 6**, Guck discloses:

Guck discloses "editing first and second formatted messages and sending a copy of the formatted message to a computer message file" on col. 6, lines 49-64 teaches author or user-

sender selects among various formats to reformat his document to send to various recipients and

on col. 12, lines 56-65 teaches creating a file and defining the file in a alternate format.

**Regarding dependent claims 7 and 9**, Ferrel discloses:

wherein said first and second composition areas and said formatted message display area

are formed in a template that is presented on a web page, and wherein steps (e) and (f) are

performed via said web page (Ferrel on col. 3, lines 46-65 teaches using Word template to help

author produce documents with valid embedded codes).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Ferrel into Guck to provide a way to author documents

from Rich Text format (RTF) to be converted into a MDF being a MPML markup language

tagged storage, as taught by Ferrel, incorporated into the converting of RTF into TIFF, as taught

by Guck, in order to provide the ability to place embedded objects within the structure of the

document in an authoring environment.

### *Response to Arguments*

12.      Applicant's arguments with respect to claims 1-24 have been considered but are moot in

view of the new ground(s) of rejection.

## *Conclusion*

13.     Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Almari Yuan whose telephone number is 703-305-5945. The

examiner can normally be reached on Mondays - Fridays (8:30am - 5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Feild, can be reached on 703-305-9792. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AY
March 5, 2004

SANJIV SHAH
PRIMARY EXAMINER